

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today
(1) was not written for publication in a law journal and
(2) is not binding precedent of the Board.

Paper No. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JAMES P. GREANEY

Appeal No. 1996-2844
Application 07/955,162

ON BRIEF

Before CAROFF, HANLON and WALTZ, Administrative Patent Judges.
CAROFF, Administrative Patent Judge.

DECISION ON APPEAL

This decision on appeal relates to the final rejection of
claims 1-2.

The claims on appeal are directed to a phosphate-free,
substantially anhydrous anti-corrosive antifreeze formulation.

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Claim 1 is illustrative:

1. A phosphate-free, substantially anhydrous anti-corrosive antifreeze formulation suitable for use as coolant in an engine cooling system without water dilution consisting essentially of:

<u>COMPONENT</u>	(WT%) <u>CONCENTRATION RANGE</u>
Propylene Glycol	92 to 98
Borate, calculated as B_4O_7	0.16 to 0.81
Molybdate, calculated as MoO_4	0.13 to 0.66
Nitrate, calculated as NO_3	0.073 to 0.36
Nitrite, calculated as NO_2	0.067 to 0.33
Tolyltriazole ($C_7H_7N_3$)	0.15 to 0.50
Silicate, calculated as SiO_2	0.014 to 0.07

As culled from the examiner's Answer (Paper No. 15) and Supplemental Answer (Paper No. 18), the posture of this appeal is as follows:

Ž all of the rejections previously applied in the final rejection have been withdrawn by the examiner.

Ž the only outstanding rejections are those which were applied as new grounds of rejection in the examiner's Answer.

Ž the paper styled "Amendment" filed on Nov. 25, 1994 (Paper No. 16) is treated as a Reply Brief responding to the new grounds of rejection.

Ž the only other claim pending in appellant's

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application, claim 3, was added by way of the aforementioned Amendment (Reply Brief), and the examiner's Supplemental Answer indicates that claim 3 is allowed over the art of record.

Ž the examiner's Answer incorrectly states that the "copy of the appealed claims contained in the Appendix to the brief is correct." In fact, we note that the copy of claim 2 is incorrect in that "fear" on line 3 should instead read "water".

The following three prior art references are relied upon by the examiner to support the rejections at issue:

Daignault et al. (Daignault)	3,228,884	Jan. 11, 1966
Hirozawa	4,452,715	June 5, 1984
Van Neste et al. (Van Neste)	4,851,145	July 25, 1989

The following grounds of rejection are before us for consideration:

I. Claim 1 stands rejected under 35 U.S.C. § 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. § 103 as being obvious over Van Neste.

II. Claims 1-2 stand rejected for obviousness under 35 U.S.C. § 103 in view of Van Neste taken in combination with

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Daignault and Hirozawa.

We have carefully considered the entire record in light of the opposing positions presented on appeal. Having done so, we conclude that the examiner has established a prima facie case of unpatentability which is not outweighed by evidence upon which appellant relies. Accordingly, we shall affirm the rejections at issue.

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Briefly stated, we agree with the examiner that Van Neste anticipates, or at least renders obvious, appellant's claimed invention essentially for the reasons presented in the examiner's Answer and Supplemental Answer.

For emphasis, we note that the Van Neste disclosure encompasses all of appellant's claimed antifreeze components as well as the claimed concentration ranges. There appears to be little question that the Van Neste composition, as formulated according to the Van Neste disclosure, would be phosphate-free and substantially anhydrous. As for the claim expression "suitable for use as coolant in an engine cooling system without water dilution", we note that statements of intended use in the preamble of a composition claim ordinarily carry little patentable weight. See In re Tuominen, 671 F.2d 1359, 1361, 213 USPQ 89, 90 (CCPA 1982); In re Pearson, 494 F.2d 1399, 1403, 181 USPQ 641, 644 (CCPA 1974). In any event, appellant's specification (page 3, l. 13-18) suggests that the use of certain anhydrous antifreeze formulations without water dilution is known in the prior art.

Appellant urges that the expression "consisting

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essentially of" in the claims excludes the synergistic combination of corrosion inhibitors which is the primary feature of the Van Neste composition. We disagree.

Appellant's specification is devoid of any indication that such additives are specifically excluded or would otherwise materially affect the basic and novel characteristics of appellant's anti-corrosive formulation. Cf.

In re Herz, 537 F.2d 549, 551, 190 USPQ 461, 463 (CCPA 1976).

Indeed, it would appear that the synergistic additives of Van Neste would only improve the anti-corrosion properties of appellant's formulation rather than materially change its fundamental character. Certainly, appellant has not shown otherwise. Accordingly, we conclude that appellant's appealed claims are inclusive of the additional synergistic components (i.e., an alkylbenzoic acid and an aliphatic monobasic acid, or their salts) disclosed by Van Neste.

We also take note of appellant's reliance on In re Geiger, 815 F.2d 686, 688, 2 USPQ2d 1276, 1278 (Fed. Cir. 1987), to support the proposition that obviousness with regard to a combination of components cannot be established absent some teaching, suggestion, or incentive in the prior art

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supporting the combination. Our conclusions and those of the examiner are consistent with Geiger for the simple reason that the Van Neste reference itself clearly and explicitly suggests a combination of corrosion inhibitors to be used along with a freezing point depressant, e.g. propylene glycol, much as claimed by appellant. In this regard, we refer to col. 4, l. 22-29 of Van Neste.

We have reviewed comparative data presented in the Greaney Declaration (Paper No. 7) upon which appellant apparently relies as evidence of unexpected results. However, the data is of little probative value for the following reasons:

First, the evidence does not appear to represent a comparison of appellant's invention with the closest prior art. See In re Johnson, 747 F.2d 1456, 1460, 223 USPQ 1260, 1263 (Fed. Cir. 1984).

Second, the evidence is not dispositive since the comparative formulation B varies from appellant's formulation A in a number of respects, in terms of both the components included and differences in component concentrations. Thus, any cause and effect sought to be proven is lost in the welter

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of unfixed variables. See In re Dunn, 349 F.2d 433, 439, 146 USPQ 479, 483 (CCPA 1965).

Third, the formulation said to represent appellant's invention (formulation A) includes three components (sodium hydroxide, a polysiloxane and a polyoxypropylene-polyoxyethylene block copolymer) which are not required at all by appellant's claims. Thus, the proffered evidence is not commensurate with the scope of the claims. See In re Grasselli, 713 F.2d 731, 743, 218 USPQ 769, 778 (Fed. Cir. 1983).

We find it unnecessary to discuss the secondary references in any detail since there is little dispute that they suggest the specific borate (Daignault) and molybdate (Hirozawa) of claim 2.

For the foregoing reasons, the decision of the examiner is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

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Administrative Patent Judge)	
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)	BOARD OF PATENT
ADRIENE LEPIANE HANLON)	
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